

No. 15188

IN THE

# United States Court of Appeals

FOR THE NINTH CIRCUIT

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LEO MANTIN,

*Appellant,*

*vs.*

BROADCAST MUSIC, INC., a corporation, *et al.*,

*Appellees.*

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## APPELLANT'S REPLY BRIEF.

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## APPELLANT'S REPLY BRIEF.

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### Preliminary Statement.

The District Court Judge granted the motion to dismiss *solely* on the basis of the statute of limitations, California Code of Civil Procedure, Section 339.1 [R. 48-51]. For this reason, Appellant's Opening Brief concerned itself solely with the statute of limitations problems of the case.

Appellee's Answering Brief fails to answer, or even discuss, most of the fundamental limitation arguments advanced by appellant. These unanswered arguments, and the authorities cited in support, require reversal and a trial on the merits.

Instead of dealing with the limitations problems—the fundamental problems on this appeal—appellees devote approximately one-half of their argument to the assertion that appellant has “published” his musical composition. This assertion is without any merit whatever. It was rejected by the court below [R. 49-50] on the basis of overwhelming authority, which will be discussed at Point IV, *infra*.

I.

None of Plaintiff's Claims for Damages for Infringements Occurring Within Two Years Prior to the Commencement of This Lawsuit Is Barred by the Statute of Limitations.

- A. Defendants Ignore the Well Settled California Rule That Successive, Repeated or Continuous Torts Each Create New or Separate Causes of Action, so That Each Exhibition of Defendants' Motion Picture and Each Sale of Sheet Music or Phonograph Records, as Well as Each Radio Broadcast Constitutes a Fresh Infringement.

The facts relating to the new and different infringements committed by each of the defendants are fully stated in appellant's opening brief (pp. 6-9, 14-16). The complaint clearly alleges that all of the infringements were continuous from the time of commencement to the date the complaint was amended on April 18, 1955 [R. 17-19]. None of the defendants except Romulus and United Artists Corporation committed *any* infringing act prior to February 1, 1953 (within two years prior to the commencement of the action). The defendants Romulus and United Artists Corporation exhibited the infringing motion picture a few times prior to the commencement of the two-year period, but have continuously and successively exhibited the motion picture since that date in California and elsewhere throughout the world.

Plaintiff's fundamental contention as to these two defendants is that their tort was continuing and repeated in nature. The essential damaging acts were the continued and repeated exhibitions of the motion pictures containing innumerable unauthorized performances of plaintiff's original composition. Damage by unauthorized public exhibition or performance is an integral element of the tort. (*Golding v. R. K. O. Pictures*, 35 Cal. 690, 696, 221 P. 2d 95, 97 (1950); *Cain v. Universal Pictures*

Co., 47 Fed. Supp. 1013, 1017-1018 (D. C. Cal., 1942); 34 Am. Jur. 416-417.)

Under well-settled California law, "Where the tort is continuing, the right of action is also continuing," and is not barred by the statute of limitations. (*Trombley v. Kolts*, 29 Cal. App. 2d 699, 708, 85 P. 2d 541, 545 (1938).) A tort which "may be discontinued at any time . . . is . . . continuing in character" and each repetition constitutes ground for a separate action. (*Phillips v. City of Pasadena*, 27 Cal. 2d 104, 107-108, 162 P. 2d 625, 626-627 (1945).)

In the case of repeated or continuously damaging acts, the statute begins to run anew upon the commission of each successive damaging act. (*Phillips v. City of Pasadena*, *supra*; *Kafka v. Bozio*, 191 Cal. 746, 218 Pac. 753 (1923); *Landberg v. Linder*, 133 Cal. App. 213, 218 (1933); *Cf. Kornoff v. Kingsbury Cotton Oil Co.*, 45 Cal. 2d 265, 268-271, 288 P. 2d 507 (1955); 34 Am. Jur. 127.)

Furthermore, as stated in *Carbine v. Meyer*, 126 Cal. App. 2d 386, 390, 272 P. 2d 849, 853 (1954):

"In all cases of doubt respecting the permanency of the injury, the court are inclined to favor the right to successive actions. (*Kafka v. Bozio*, *supra*, p. 753.)"

*These well-established rules—rules that conclude the present appeal against defendants—are not even mentioned by defendants in their brief. There is no attempt by the defendants to distinguish or even discuss the cases upon which the rule is based.*

Instead, defendants rely exclusively upon *Italiani v. Metro-Goldwyn-Mayer Corporation*, 45 Cal. App. 2d 464, 114 P. 2d 370 (1941), which we have fully discussed in our opening brief, pages 18-19. Space limitations preclude restatement of that argument. The simple fact

remains that neither counsel nor the court, in the *Italiani* case, gave any consideration whatever to the problem of continuous or repeated infringement either by the same defendant or by *different* defendants in *different* media of communications, *e.g.*, radio, phonograph records, sheet music, sales, etc.

**B. Defendants Ignore the Well-settled Rule That the Author or Composer Owns a "Bundle" of Common Law Rights, the Invasion of Any One Giving Rise to a New and Separate Cause of Action as to Each New Defendant-Invader.**

Appellees argue that the distinction between common law copyright and statutory copyright is such that as soon as an infringer violates a composer's common law right, the composer's work is "made public," and unless the composer seeks redress based on that first infringement within two years, he loses all of his rights against the infringer "and those who claim under him" (Appellees' Ans. Br. pp. 15-19).<sup>2</sup>

This argument is based on the premise that the "primary right recognized at common law is the right to first publication of the work" and that "all other common law rights stem from that right" (*Id.*, p. 16). Defendants argue from this premise that if the first "publication" is a wilful infringement (of course, not authorized or con-

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<sup>2</sup>Defendants' contention impliedly concedes that unless the other defendants "claim under" the first infringers, the plaintiff may maintain his action.

There is nothing in the record to sustain appellees' suggestion that the other defendants "claim under" either of the defendants Romulus or United Artists Corporation.

Furthermore, defendants expressly *admit* that notwithstanding the first literary theft "by the first appropriator", "*the author may retain his rights to damages or an injunction if he acts in time against other members of the public who publish the work without permission*" (Appellees' Ans. Br. p. 18).



sented to by the composer) and goes unredressed for two years, all other rights are lost, despite the fact that the infringement is continuous and repeated. Defendants try to make the *Italiani* case, 45 Cal. App. 2d 464, 114 P. 2d 370 (1941), stand for their contention (Appellees' Ans. Br. pp. 17-18).

The fallacious argument never appeared in the *Italiani* case. As presented by the briefs, the Court in *Italiani* was simply called upon to decide whether the two or three year statute applied; the plaintiff's theory being one of simple "conversion" of his property. No one briefed any other point. The Court decided no other point.

Furthermore, appellant's entire argument is incorrect: Common law rights in literary or musical property do not consist primarily of the single right of first publication. The property which an author has in his intellectual productions consists, as in the case of ownership of any property, of a "bundle of rights" which include, among others, the following:

1. The sole right to retain the property in manuscript form perpetually (18 C. J. S. 140; 13 C. J. S. 951).
2. The exclusive right "to possess, use and dispose of [the] intellectual production" (18 C. J. S. 139).
3. The right to prevent use or disposition by others (18 C. J. S. 140).
4. The right to circulate the manuscript in a limited manner, restricting use "as he pleases." (18 C. J. S. 140; 13 C. J. 949; Ball, *The Law of Copyright and Literary Property*, 57; Amdur, *Copyright Law and Practice*, 38.)
5. The right to print without publication. (Ball, *loc. cit.*)
6. The right to copy. (Ball, *loc. cit.*)
7. The right to translate. (Ball, *loc. cit.*)
8. The right to dramatize. (Ball, *loc. cit.*)
9. The right to abridge or revise. (Ball, *loc. cit.*)

10. The right of first publication. (Ball, *loc. cit.*; 18 C. J. S. 140; Amdur, *op cit.*, p. 37.)

11. The right to assign and transfer the manuscript and the literary property rights, together or independently of one another. (18 C. J. S. 140; Ball, *loc. cit.*; Amdur, *op. cit.*, p. 39.)

12. As to musical and dramatic productions, the right of the author to perform publicly, without any loss of rights. (13 C. J. 968; 18 C. J. S. 141-142, 154; Shafter, *Musical Copyright*, 130, 131 (1939); *Golding v. RKO Pictures, Inc.*, 35 Cal. 2d 690, 693, 221 P. 2d 95, 96 (1950); *Ferris v. Frohman*, 223 U. S. 424, 435-436, 31 S. Ct. 263, 266, 56 L. Ed. 492, 497 (1912); *McCarthy & Fisher, Inc. v. White*, 259 Fed. 364, 365 (D. C. N. Y., 1919).)

This bundle of rights is perpetual in nature, and has often been described as being “*of a wider and more exclusive nature than the rights conferred by statutory copyright. . . .*” (*Stanley v. Columbia Broadcasting System*, 35 Cal. 2d 653, 661, 221 P. 2d 73, 78 (1950) (emphasis in original); *Yadkoe v. Fields*, 66 Cal. App. 2d 150, 160, 151 P. 2d 906, 911 (1944).)

It is a tort to invade any of these sole and exclusive rights, to the plaintiff's damage. (18 C. J. S. 158; *Stanley v. Columbia Broadcasting System*, 35 Cal. 2d 653, 661, 221 P. 2d 73 (1950).)

It is impossible to define the right of first publication as “primary,” or the source “of all other common law rights” as appellees seeks to do (Appellees' Ans. Br. p. 16). *The authorities cited by appellees stand for no such proposition, and we know of no such authority.*

The “right of first publication” is not the great source of all other rights. On the contrary, it is the act by which those rights may be lost. Infringement of that right, like infringement of any other common law rights, gives rise to a cause of action. If the cause of action

for the first infringement becomes barred by the statute of limitations, remedy for that infringement alone is lost; or in the case of continued and repeated infringements, the right to seek damages beyond the statutory period is lost. Nothing more.

To completely bar all of plaintiff's rights and remedies against all subsequent infringers two years after the date of first infringement, is to interpret the California Statute of Limitations as equivalent to an adverse possession statute, which it certainly is not. Even appellees do not make such an assertion before this Court.

Nor do appellees improve their position by describing themselves as persons who have committed "theft" (Appellees' Ans. Br. p. 18). By characterizing their acts as "theft" and by describing the thing stolen as "the primary right," they change nothing. They still cannot establish their proposition that the infringement is "immediately complete," and all of plaintiff's rights and remedies against future infringements *forfeited* if he does not seek redress for the first infringing act (Appellees' Ans. Br. p. 18).

The California law of repeated and continuous damaging acts heretofore referred to in this brief, which has been applied in a variety of comparable tort situations, is equally applicable here. The damage is not "immediately complete" in cases where the damaging act may be discontinued by the defendants.

Moreover, the law is well-settled that each separate invasion of rights in literary or musical property gives rise to a separate cause of action. The authorities on this point are set forth in our opening brief, pages 24-25, 28. Defendants do not even discuss them, merely claiming the rule of separate infringement is applicable to statutory copyright but not to separate and successive infringements of common law rights. They cite no authority for this distinction and *ignore* the authorities quoted in our opening brief directly to the contrary. (See Appellant's Op. Br. p. 35.)



C. None of Plaintiff's Claims Against Defendant Music Publisher (BMI), Defendant Record Companies, and Defendant Broadcasting Companies Are Barred by the Statute of Limitations.

Retreating from the position primarily asserted in the District Court where these defendants claimed, in effect, that California Code of Civil Procedure, Section 339.1, operated as an adverse position statute against literary property, these defendants now assert that their rights are "derivative" and that they are in the position of "claiming under" defendants Romulus and United Artists (Appellees' Op. Br. pp. 18, 21).

This argument is quickly refuted. There is not one allegation in the pleadings, or one fact in the record, which places these defendants in that position. The simple fact is that none of these defendants commenced an infringement until February 1, 1953—within the limitation period. These defendants seek to absolve themselves from all liability by arguing that the same infringing song was used by each of the defendants. It is impossible for them to proceed from this point to establish that they are "derivative" infringers, even if such a category could exist. These defendants could have been licensed by the infringing "composer," or they could have infringed without putative rights of any sort.

Moreover, if the record is inspected, it will be found that it is defendant BMI, *not* Romulus *nor* United Artists, which took out the purported federal "copyright" on the infringing composition [R. 42-43]. Yet, BMI comes before this Court claiming its "rights" are "derivative" from the "rights" of the "first appropriator."

There is no factual basis to support this claim of "derivative" putative rights. Moreover, plaintiff is entitled to the benefit of "the most favorable inferences" which can be drawn from the record. (*Sidebotham v. Robison*, 216 F. 2d 816, 831 (9th Cir., 1955).)

Plaintiff is further entitled to have the case reviewed "in the aspect most favorable to the plaintiff and most unfavorable to the defendant." (*Woods v. Hillcrest Terrace Corporation*, 170 F. 2d 980, 984 (8th Cir., 1948).)

Furthermore, it is well-established California law that a plaintiff may not be denied his day in Court if the demurrer based on a statute of limitation "merely shows that the action *may* have been barred. It must affirmatively appear that, upon the facts stated, the right of action is necessarily barred." (*Vassere v. Joerger*, 10 Cal. 2d 689, 693, 76 P. 2d 656, 658 (1938); *Miller v. Brown*, 107 Cal. App. 2d 304, 307, 237 P. 2d 320 (1951); *Pike v. Zadig*, 171 Cal. 273, 152 Pac. 923.)

Such is not the case here. In any event, it makes no difference whether these defendants copied directly from plaintiff or from those who copied from plaintiff. (*Wihtol v. Wells*, 231 F. 2d 550, 553 (7th Cir., 1956).)

Furthermore, *as a matter of law*, the so-called "derivative" infringements are equally culpable separate infringements, giving rise to separate causes of action. (*Encore Music Publications v. London Film Productions*, 89 U. S. P. Q. 501, 28 Copyright Bulletin 144 (D. C., N. Y., 1951); *Northern Music Corp. v. King Record Distributing Co.*, 105 Fed. Supp. 393, 400-402 (D. C. N. Y., 1952).)

The facts in the record speak for themselves as to these defendants. *Not one of them committed a single infringing act before February 1, 1956*—a date which does not fall within the bar of the limitation statute. (The facts are set forth in detail at p. 38 of our opening brief.) Therefore, no cause of action could possibly have accrued to plaintiff against these defendants until *after* that date.

*It is uncontestably the law of California that no statute of limitation can begin to run until a cause of action accrues to the plaintiff.* (Cal. Code Civ. Proc., Sec. 312; *Irvine v. Bassar*, 25 Cal. 2d 652, 658, 155 P. 2d 9, 13 (1944); *Lubin v. Lubin*, 144 A. C. A. 898, 906 (1956); 16 Cal. Jur. 488-490.)

Plaintiff is, therefore, entitled to his day in Court against these defendants. The judgment of dismissal should be reversed as to plaintiff's first cause of action.

## II.

### Plaintiff's Claims of Unfair Competition Against All Defendants, Contained in His Second Count, Are Not Barred by the Statute of Limitations.

The record reveals that public confusion and deception, began during the year 1953 as to plaintiff's composition [R. 10]. There is nothing in the record which indicates the date of commencement of public deception and confusion as *prior* to January 19, 1953. It is not so alleged by plaintiff, and defendants have not moved under Federal Rules of Civil Procedure, Rule 12b, to show that they committed no act of deception or confusion within the statutory period. Plaintiff's complaint expressly alleged that public deception *began on February 1, 1953*, as to plaintiff's title [R. 11]. There is no basis, therefore, for an argument that plaintiff is barred by a two-year statute of limitation with respect to his causes of action for unfair competition.

Plaintiff is entitled to have all inferences resolved in his favor. (*Sidebotham v. Robison*, 216 F. 2d 816, 831 (9th Cir., 1955); *Woods v. Hillcrest Terrace Corporation*, 170 F. 2d 980, 984 (8th Cir., 1948).) The cause of action certainly is not "necessarily" barred, as it must be before plaintiff can be denied his day in Court. (*Vassere v. Joerger*, 10 Cal. 2d 689, 693, 76 P. 2d 656, 658 (1938); *Miller v. Brown*, 107 Cal. App. 2d 304, 307, 237 P. 2d 320; *Pike v. Zadig*, 170 Cal. 273, 152 Pac. 923.)

Furthermore, in any event, the tort is continual and repeated and, therefore, even if it were commenced before the limitation period, the only bar would be as to damages accrued prior to January 19, 1953. (4 Callmann, Unfair Competition and Trademarks, 1784, n. 2 (1950); *cf. Curtis v. Twentieth Century-Fox Film Corp.*,

140 Cal. App. 2d 461, 464-465, 295 P. 2d 62, 64 (1956); *Trombley v. Kolts*, 29 Cal. App. 2d 699, 708, 85 P. 2d 541, 545 (1938); *Phillips v. City of Pasadena*, 27 Cal. 2d 104, 107-108, 162 P. 2d 625, 626-627 (1945); *Kafka v. Bozio*, 191 Cal. 746, 218 Pac. 753 (1923); *Carbine v. Meyer*, 126 Cal. App. 2d 386, 390, 272 P. 2d 849, 853 (1954); 34 Am. Jur. 127.)

Defendants make no answer which has any support in authority. They argue that plaintiff can sue for unfair competition only if he can also sue for invasion of his common law rights (Appellees' Ans. Br. pp. 19-21). It has been authoritatively held that allegations of public confusion, deception and unfair competition differentiate the case completely from a case of simple invasion of common law rights in intellectual property. The tort is not complete until the element of public or industry confusion and deception is present. (*Leo Feist, Inc. v. Song Parodies*, 146 F. 2d 400 (2nd Cir., 1944); *Collins v. Metro-Goldwyn Pictures Corporation*, 106 F. 2d 83, 85 (2nd Cir., 1939), approved in *Reeves v. Bandall*, 316 U. S. 283, 284, 62 S. Ct. 1085, 1087, 86 L. Ed. 1478, 1479 (1942), and *Sears, Roebuck & Co. v. Mackey*, 351 U. S. 427, 438, 76 S. Ct. 895, 901, 100 L. Ed. 1297 (1956); see also *Curtis v. Twentieth Century-Fox Film Corp.*, 140 Cal. App. 2d 461, 464, 465, 295 Pac. 62, 64 (1956).)

Defendants have made no attempt to distinguish or discuss plaintiff's authorities cited in our opening brief, pages 42-46. We reaffirm our contention that the tort of unfair competition differs from the tort of invasion of common law rights in musical property and contains different elements. The essential distinguishing element—confusion and deception of the public and the industry—arose within the two-year period.

Plaintiff is, therefore, entitled to reversal as to the second count.



III.

**Plaintiff's Claims for Injunctive Relief and an Accounting Against All Defendants, Contained in His Third Count, Are Not Barred by the Statute of Limitations.**

Appellees make practically no argument to support their assertion that plaintiff's equitable rights to an injunction and an accounting are barred by Code of Civil Procedure, Section 339.1, the sole statute upon which they rely [R. 15].

They ignore the long line of authority which holds that a suit for equitable relief is subject only to the four-year statute, California Code of Civil Procedure, Section 343. (*Pillar v. Southern Pacific R.R. Co.*, 52 Cal. 42, 44 (1877); *Dore v. Thornburgh*, 90 Cal. 64, 27 Pac. 30 (1891); *Freeman v. Donohoe*, 65 Cal. App. 65, 223 Pac. 431 (1923).) They do not mention *Lux v. Haggin*, 69 Cal. 255, 4 Pac. 919 (1886), which specifically held that the four-year statute applied to suits for injunction.

Appellees ignore the authorities decided under the comparable New York statute set forth in our opening brief, pages 49-51, which hold that suits in equity are amenable only to the New York equivalent of the California four-year, "catch-all" statute.

Appellees ignore the repeated California holdings that an action or suit for an accounting, whether it be considered equitable or legal, is subject only to the California four-year statute, Code of Civil Procedure, Section 343. (The cases are cited in our opening brief, pp. 52-54.)

Instead, appellees rely on dicta in a case which was decided contrary to them: *Maguire v. Hibernia Savings & Loan Soc.*, 23 Cal. 2d 719, 733, 146 P. 2d 673, 680 (1944), where the Court held that declaratory relief suits were subject to the statute of limitations. The Court, stating that the nature of the right asserted governed the

applicability of the statutes, held that a declaratory relief suit was not barred until the action or suit for “coercive” relief was barred, although the declaratory relief suit could be brought before coercive relief was available. (The Court did not determine which statute applied to the case before it.) The Court further held, under this rule, that although the controversy had developed approximately eighty years before (1864), the action was not barred.

The *Maguire* case in no way impugns plaintiff’s position that where a separate count seeks the equitable relief of injunction and accounting, that count is subject only to the four-year statute. Plaintiff does not seek a declaratory judgment in the instant case. He seeks, in a separate count, an injunction and an accounting—remedies with which the *Maguire* case was not concerned. A wealth of authority, heretofore cited in our opening brief, pages 46-54, supports plaintiff’s contention that his right to such relief, based on the nature of his right to such relief, is not barred. Four years had not elapsed.

Furthermore, in the case of a continued and repeated invasion of rights, the right to equitable relief is, of course, no more barred than the right to relief at law by time elapsing from the date of the first infringement. (*Vownickel v. N. Clark & Sons*, 216 Cal. 156, 164-165, 13 P. 2d 733 (1932) (repeated invasions over forty years, *held*, suit for injunction not barred).)

Plaintiff is, therefore, entitled to a trial on the merits of his claim for equitable relief.

IV.

**Plaintiff Has Not, by Performing His Song, Made It Public Property.**

Appellees argue that plaintiff, by singing his song in theaters, night clubs and other places of entertainment and amusement throughout the world for more than thirty years, has lost all of his common law rights (Appellees' Ans. Br. pp. 22-32). This argument, which is unsupported by authority, was rejected by the Court below [R. 49-50].

The allegations in the complaint are clearly contrary to any claim of publication, abandonment or dedication.

1. The "song and musical composition have never at any time been published in any form by plaintiff or with plaintiff's knowledge, authority and consent" [R. 6].

2. The composition has "at all times remained in manuscript form" [R. 6].

3. The plaintiff has "at all times owned and retained and does now own and retain all common law rights" [R. 6].

Appellees seek to avoid the effect of these allegations and the authoritative cases which hold that performance of a song or play does not dedicate it. They place great reliance on a law review article by Herman Selvin, a Los Angeles attorney. (Selvin, *Should Performance Dedicate?*, 42 Cal. L. Rev. 40 (1954).) Appellees have followed, to a large degree, his reasoning and have relied upon the cases he cites. But Selvin *freely admits the present, well-settled state of the law*:

" . . . in the United States at least, the rule now seems to be that performance or representation of an unpublished work, even though general, indiscriminate and unrestricted, is not a dedication of the perpetual common law right" (Selvin, *op. cit.*, p. 44).



Few propositions are as well-established in the law of literary and musical property as the one on which plaintiff now relies, and upon which he has relied for more than thirty years: *Performance of a musical or dramatic composition does not dedicate it to the public.*

*Ferris v. Frohman*, 223 U. S. 424, 435-436, 31 S. Ct. 263, 266, 56 L. Ed. 492, 497 (1912):

“At common law, the public performance of the play is not an abandonment of it to the public use. *Macklin v. Richardson*, 2 Ambl. 694, 7 Eng. Rul. Cas. 66; *Morris v. Kelly*, 1 Jac. & W. 481, 21 Revised Rep. 216; *Boucicault v. Fox*, 5 Blatchf. 87, 97, Fed. Cas. No. 3,441; *Palmer v. DeWitt*, 2 Sweeny 530, 47 N. Y. 532, 7 Am. Rep. 480; *Tompkins v. Halleck*, 133 Mass. 32, 43 Am. Rep. 480. Story states the rule as follows: ‘So, where a dramatic performance has been allowed by the author to be acted at a theater, no person has a right to pirate such performance, and to publish copies of it surreptitiously; or to act it at another theater without the consent of the author or proprietor; for his permission to act it at a public theater does not amount to an abandonment of his title to it, or to a dedication of it to the public at large.’ 2 Story, Eq. Jur., §950.”

Shafter, *Musical Copyright*, 131 (1939):

“Performance is one of those acts which do not result in loss of rights. Performance of a musical or dramatic work is not tantamount to publication—a rule observed throughout the world.”

(*Uproar Co. v. National Broadcasting Co.*, 8 Fed. Supp. 358, 362 (D. Mass., 1934), mod. on other grounds, 81 F. 2d 373 (1st Cir., 1936); *Patterson v. Century Productions, Inc.*, 93 F. 2d 486, 492 (2d Cir., 1937); *Crowe v. Aiken*, 6 Fed. Cas. 905, No. 3,441 (C. C., N. D. Ill., 1870); *Boucicault v. Hart*, 3 Fed. Cas. 983, No. 1692

(C. C., S. D. N. Y., 1875); *Roberts v. Myers*, 20 Fed. Cas. 898, No. 11906 (C. C., D. Mass., 1868); *Tompkins v. Halleck*, 133 Mass. 32 (1882); 34 Am. Jur. 446-447; 18 C. J. S. 154-155; see also: *McCarthy & Fischer v. White*, 259 Fed. 364, 365 (S. D. N. Y., 1919); *Nutt v. National Institute Incorporated for the Improvement of Memory*, 31 F. 2d 236, 238 (2d Cir., 1926.).

The California rule is, and always has been, the same. The arguments made by appellees, based on the Selvin article and *Blanc v. Lantz*, 83 U. S. P. Q. 13, 27 Copyright Decisions 61 (L. A. Super. Ct., 1949), overlook and ignore the rulings of the California Supreme Court in *Golding v. R. K. O. Pictures, Inc.*, 35 Cal. 2d 690, 221 P. 2d 95 (1950), and *Stanley v. Columbia Broadcasting System*, 35 Cal. 2d 653, 221 P. 2d 73 (1950).

While appellees urge that dedication took place on the basis of the California statutes (Civ. Code, Secs. 980, 983), as they stood prior to the 1947 amendment, the *Golding* and *Stanley* cases were both decided on the basis of the statutes prior to amendment. In the *Golding* case, the plaintiffs had publicly produced their play for several weeks at the Pasadena Playhouse during December, 1942. In an action for infringement of common law rights in literary property, the California Supreme Court, at the very beginning of its opinion, holds that plaintiffs had by such public performances "neither published (their work) nor dedicated it to the public" (35 Cal. at 693).

Likewise, *Stanley v. Columbia Broadcasting System*, 35 Cal. 2d 653, 221 P. 2d 73 (1950) (which appellees claim "buttresses" their argument), in fact holds *directly contrary* to defendants' contention that public performance in California *prior* to 1947 was sufficient "making public" to dedicate or abandon all common law rights. The California Supreme Court there held that *free* performance of a radio program before a studio audience of several hundred persons was *not* a general publication

or dedication. While the Court cast its opinion in the language of limited publication, the case was argued<sup>3</sup> and decided on the same principles and cases now presented to this Court by appellant. The California Supreme Court, in rejecting defendants' contention that there had been a publication, relied on the very authorities now relied on by appellant, 35 Cal. 2d 653, 666, 221 P. 2d 73 (see cases cited *supra*, pp. 15-16). They are authorities which hold that performance of a musical or dramatic composition does not dedicate.

There is no basis for appellees' claim that plaintiff's audiences were any less "select" than theatrical audiences anywhere. Nor is there any basis for appellees' distinction with respect to the number of persons who are alleged to have heard the plaintiff sing his song. The greater the composer's success (*e.g.*, "Oklahoma," "South Pacific"), the more the need for his protection. The same rule of law applies whether the number of performances is one or a thousand.

Moreover, even if the type of audience is important, as appellees argue, there is no basis for distinguishing the instant case from either *Stanley* or *Golding*. The studio audience in the *Stanley* case paid *no admission fee*, whereas, the Court can take judicial notice, as Justice Holmes once did in a comparable case, that audiences in theaters and night clubs pay a substantial amount for the limited purpose of hearing and seeing the performances—not reproducing them. (*Cf. Herbert v. Shanley Co.*, 242 U. S. 591, 594-595, 61 L. Ed. 511, 512 (1917).)

Furthermore, any change even if made in 1947 inures to the benefit of the plaintiff herein. Section 983, California Civil Code, formerly used the phrase "makes it public" to describe the act necessary for dedication. When

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<sup>3</sup>See, *Stanley v. Columbia Broadcasting System*, Appellant's Opening Brief, pp. 70-75; Brief for Respondent, pp. 52-63.

the code was changed in 1947, the phrase "makes it public" was deleted and the common law word "publish" was inserted. Therefore, if the change in the statutory language is to be given any effect (see *Stamper v. Schemmel*, 69 Cal. App. 2d 449, 454 (1945)), it must be interpreted as reinforcing the rule that California follows the common law principles well established and widely recognized in this country, as the cases heretofore cited make clear. (See also: *Johnston v. Twentieth Century-Fox Film Corp.*, 82 Cal. App. 2d 796, 187 P. 2d 474 (1947).)

Appellees rely principally upon a *nisi prius* decision of the Superior Court in Los Angeles County, *Blanc v. Lantz*, 830 U. S. P. Q. 13, 27 Copyright Decisions 61 (L. A. Super. Ct., 1949). In that case, "Woody Woodpecker's laugh" ("Ha-Ha, Ha-Ha, Ha-Ha") was prior to defendants' alleged infringement, broadcast over the radio and reproduced in motion pictures *with plaintiff's consent*. The motion pictures were placed in general public release and distribution. The Court held that this constituted a general publication with resultant loss to plaintiff of all his rights. There are no such facts in the instant case.

Furthermore, the *rationale* of the case (aside from the "publication" in motion pictures) has been universally condemned. One distinguished commentator in referring to the argument of the Superior Court judge (which has been adopted by appellees) stated:

"This argument repudiates 300 years of legal history . . . The *Mel Blanc* case constitutes an anomaly in the field of common law copyright and its holding that a performance is a general publication should be reversed on appeal." (Warner, Radio and Television Rights, 877, 880 (1953).)

Unfortunately, the decision was not appealed. It remains an anomaly frozen in the archives of the Los Angeles County Superior Court, not binding on this Court



(*King v. United Commercial Travellers*, 333 U. S. 351, 68 S. Ct. 488, 92 L. Ed. 608 (1948), reh. den. 333 U. S. 878, 68 S. Ct. 900, 92 L. Ed. 1153 (1948)), repudiated by the *Golding* and *Stanley* cases, *supra*, decided by the California Supreme Court less than a year later, and completely distinguishable from the instant case. Here the plaintiff only sang his song; he did not broadcast it by radio, sell and distribute it in a motion picture, nor produce and sell it on phonograph records. Plaintiff performed his song in the most ancient manner known to civilization—he sang it. There is no basis for equating bare performances with a general publication by printing sale or public distribution.

The other cases cited by appellees, such as *Loew's Incorporated v. Superior Court*, 18 Cal. 2d 419, 1151 P. 2d 983 (1941); *Marx v. United States*, 96 F. 2d 204, 206 (9th Cir., 1938); *White v. Kimmel*, 193 F. 2d 744, 746 (9th Cir., 1952); *Egner v. E. C. Schirmer Music Co.*, 48 Fed. Supp. 187 (D. C. Mass., 1942), affirmed on other grounds 139 F. 2d 398 (1st Cir., 1943); and *RCA Mfg. Co., Inc. v. Whiteman*, 114 F. 2d 86 (2d Cir., 1940), are not in point. They are clearly distinguished in the appendix to this brief. Space limitation precludes their discussion here.

These are the authorities primarily relied on by defendants. The few remaining cases cited by defendants are either clearly distinguishable or clearly opposed by other more recent authorities in the same jurisdiction (*e.g.*, *Keene v. Wheatley*, 14 Fed. Cas. 180, 192, 201, No. 7644 (C. C. E. D. Pa., 1861), is opposed by the Supreme Court holding in *Ferris v. Frohman*, 223 U. S. 424, 32 S. Ct. 263, 56 L. Ed. 492 (1912).)

While appellees seek to rationalize isolated decided cases into a "performance spectrum" (Appellees' Ans. Br. p. 31), the truth is that no authoritative case holds expressly, or by implication, that the simple performance by the

author of his work can constitute a dedication. Conclusive authorities, from the United States Supreme Court in *Ferris v. Frohman, supra*, to the California Supreme Court in *Golding v. R.K.O. Pictures, Inc., supra*, and *Stanley v. Columbia Broadcasting System, supra*, all hold that such performance does not and never did dedicate the author's rights.

This principle has long been accepted by the public and throughout the vast machinery of the entertainment industry. A decision in accordance with appellees' contentions would destroy property whose value reaches into millions of dollars. A decision in accordance with appellees' contentions would also overturn, by judicial fiat, the mandate of Congress in Section 2 of the Copyright Act, 17 U. S. C. 2, 61 Stats. 652 (1947) and the settled law of the land.

There was no abandonment, dedication or publication by appellant, and the lower court expressly so held [R. 49-50].

### Conclusion.

The judgment should be reversed.

Respectfully submitted,

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## APPENDIX.

### Appellees' Additional Cases Distinguished.

In addition to *Blanc v. Lantz*, 830 U. S. P. Q. 13, 27 Copyright Decisions 61 (L. A. Super. Ct., 1949), appellees cite the following cases which are clearly distinguishable:

Appellees first refer to a dictum in the case of *Loew's Incorporated v. Superior Court*, 18 Cal. 2d 419, 1151 P. 2d 983 (1941), where the Court noted that differing statements have been made on the effect of performance. The Court's dictum must be placed in context. The decision holds that the author may elect between common law and statutory rights, but after seeking federal copyright protection for an unpublished manuscript, he may not also assert a common law right to prevent performance:

*"The common law right exists until the statute has been invoked and rights created thereunder, or the common law right has otherwise been abandoned; and this is so in one case as in the other. The author has the right of election, that is, he may content himself with his common law copyright, or he may elect to substitute therefor the right afforded by the statute by complying with its provisions, whereupon the extent of his copyright and the remedies for infringement are governed by the statutory provisions"* (emphasis supplied) (18 Cal. 2d 424).

The *Loew's* case thus decided *nothing* with reference to the effect of performance by the owner of common law rights. That decision came nine years later in the *Stanley* and *Golding* cases, discussed in our main brief, which squarely hold that performance under circumstances similar to those in the instant case, *does not dedicate*.

Section 2 of the Copyright Act, 170 U. S. C. 2, 61 Stats. 652 (1947) reserves to the author his common



law rights. Defendants concede this (Appellees' Op. Br. p. 16). Those rights have, always, as we pointed out above, been considered *perpetual* in nature. The policy of Congress is clear. To obtain the benefits of the Copyright Act, the author surrenders his common law rights, but if he does not wish to do so, his common law rights—rights always considered perpetual in duration—remain intact. This fundamental principle is expressly recognized in *Loew's Incorporated v. Superior Court*, 18 Cal. 2d 419, 424 (1941), and forms the basis for the *Stanley* and *Golding* decisions.

In casting about for authority, defendants cite two cases decided by this Court, *Marx v. United States*, 96 F. 2d 204, 206 (9th Cir., 1938), *White v. Kimmel*, 193 F. 2d 744, 746-747 (9th Cir., 1952) (Appellees' Ans. Br. p. 27). These cases are cited for the proposition that this Court has held a radio performance to be a publication. There was no radio performance in the instant case.

Furthermore, the *Marx* case does not stand for the proposition attributed to it by defendants. It was there held that deposit of a copy of a manuscript was sufficient to constitute a publication under Section 11 of the Copyright Act and, therefore, that section was constitutional. The court, in affirming appellant's criminal conviction for having infringed and aided and abetted the infringement of a copyrighted composition, does not even mention the problem of what constituted a dedication by an author or owner.

The *White* case did not involve performance of a musical or dramatic composition. It involved publication of a manuscript by mimeographing, the equivalent of printing.

*Egner v. E. C. Schirmer Music Co.*, 48 Fed. Supp. 187 D. C. Mass., 1942), aff'd 139 F. 2d 398 (1st Cir., 1943), cited by appellees involved abandonment by the

author who permitted his song to be indiscriminately used by others. No such situation exists here. The point is not discussed by the Court of Appeals, which decided the case on other grounds.

*RCA Mfg. Co., Inc. v. Whiteman*, 114 F. 2d 86 (2d Cir., 1940), cert. den. 311 U. S. 712, 61 S. Ct. 393, 85 L. Ed. 463 (1940), cited by appellees involved the general "absolute" sales of phonograph recordings to the public. No such fact exists here. No recording for sale was ever made by plaintiff. Moreover, the *Whiteman* case is no longer authority in the jurisdiction where it was decided. *Capitol Records v. Mercury Records Corporation*, 221 F. 2d 657, 663 (2d Cir., 1955):

"Our conclusion is that the quoted statement from the RCA case is not the law of the State of New York."

See also, *Waring v. WDAS*, 327 Pa. 433 (1937); *Waring v. Dunlea*, 26 Fed. Supp. 338 (D. C. E. D. N. C., 1939), Note Harv. L. Rev. 171 (1937).